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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,605	04/30/2001	Akira Ichikawa	Q64273	9350

7590 10/19/2004

Sughrue Mion Zinn
Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,605

Applicant(s)

ICHIKAWA ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 9/15/2004. Applicants' amendment to claim 1 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, after considering Applicants' arguments (Remarks, pages 4-5), the Examiner withdraws the rejection in section 4 of prior Office action dated 3/17/2004. Finally, a copy of initialed IDS of 11/19/2003 is attached to this Office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by Tanimura et al. (US 6065701), generally as set forth in section 5 of Office action dated 3/17/2004, together with the following additional response to argument.

It is noted that newly amended claim 1 now recites *inter alia* "when said adhesive label is applied to an article, said adhesive layer comes into direct contact with the surface of the article".

First, the Examiner repeats the relied upon prior art as follows:

Tanimura's invention is directed to a label comprising electronic components (Abstract). In Fig. 2, Tanimura shows an adhesive label having an antenna wiring and an IC (electronic components) formed on a polyimide substrate 16, and an adhesive layer 17. An exfoliative paper 18 (release layer) is laminated on the adhesive layer 17, which is a layer of "both faces adhesive material" (i.e., double sided pressure sensitive adhesive layer) for adhering the label to a video cassette tape (column 4, lines 7-8). Tanimura also teaches a coated paper layer 12 as an outer surface layer for carrying information such as the title, recording date, and recording place of the video data recorded on a video tape (column 3, lines 52-56).

For claims 1 and 2, Tanimura teaches the invention as claimed.

For claim 4, Fig. 2 clearly shows that adhesive layer 17 covers the electronic components (i.e., the entire data carrier element).

For claims 5 and 7, Tanimur's coated paper layer 12 reads on the surface layer as claimed.

Claims lack novelty.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission, generally as set forth in section 5

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of Office action dated 3/17/2004, together with the following additional response to argument.

For claim 6, Tanimura lacks a specific teaching that the electronic components may be formed on both surfaces of the polyimide substrate. However, it is noted that Applicants appear to have admitted that an adhesive label containing a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, with connecting through-hole in the latter case, is conventional and well known (Specification, pages 1-2, bridging paragraph). As such, it would have been obvious to one of ordinary skill in the art to optionally mount the contact-less data carrier element mounted on one or both surfaces of a circuit substrate. It should be noted that the selection of a known equivalent device based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

With respect to Applicants' argument "the surface carrying the IC chip 2 and electronic circuit 21 on the circuit substrate 1 of the present invention faces the surface of the article 6, whereas the surface carrying the IC 20 and the antenna wiring 30 on the polyimide substrate 16 of Tanimura et al does not face the surface of the cassette ..." (Remarks, pages 7-8, bridging paragraph), the Examiner notes that the rejection is based on the combined teachings of Tanimura and Applicants' own admission, which expressly discloses that mounting a contact-less data carrier element on one or both surfaces of a circuit substrate is conventional and well known, as set forth above, Applicants' argument to the cited references individually notwithstanding.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

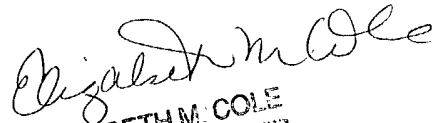
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC

Victor S Chang
Examiner
Art Unit 1771

10/5/2004


ELIZABETH M. COLE
PRIMARY EXAMINER